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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,873	06/08/2007	Holger Listle	10191/4418	3733
26646 7590 07/21/2011 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
CHEN, SHELLEY				
ART UNIT		PAPER NUMBER		
3661				
MAIL DATE		DELIVERY MODE		
07/21/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/590,873

**Applicant(s)**

LISTLE, HOLGER

**Examiner**

SHELLEY CHEN

**Art Unit**

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7, 10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-040)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendments/Arguments***

1. Applicant's arguments filed 27 May 2011 have been fully considered but are not persuasive. Arguments are addressed in the rejections below.

### ***Drawings***

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 7, 10, and 12-13 rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is a process that is not tied to a particular machine or apparatus (except in preamble and optional limitation (b)), and does not particularly transform a particular article to a different state or thing. Therefore, the claims are non-statutory.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 7 and 10, and 12-13 rejected** under 35 U.S.C. 103(a) as being unpatentable over **Barkowski et al.** (DE 10155485, see machine translation) in view of **Person** (U.S. Patent # 5,067,081).

**Regarding claim 7**, Barkowski (figures 1-2, etc) discloses a method for operating a vehicle navigation system by enabling navigation data (see title) which is stored on a data carrier (DE doc: P14, or machine translation: page 3 paragraph 3 etc), and enabling the useful data for an area definable by a user of the useful data (DE doc:

P19 and 23-25, or machine translation: page 4 paragraph 4 and page 5 paragraphs 1-3, etc). According to Barkowski's invention, a user defines a region of map data that he wants to enable, and transmits his defined region (along with other data) to a remote server. In response, the remote server transmits a key to unlock/enable the defined region of map data. The region may be a geographical region such as northern Germany. In the machine translation, the term translated as "de-energising" is equivalent to the claimed term "enabling".

Barkowski does not disclose defining the area by the user by defining a center point and a radius of a circular region.

In the same field of endeavor, Person discloses a similar method for operating a vehicle navigation system including enabling the useful data for an area defined by the user by defining a center point and a radius of a circular region (fig 4, col 3: 44-51, col 7: 16- col 8: 12, etc).

It would have been obvious at the time of the applicant's invention to modify Barkowski to define the area by center point and radius, as taught by Person, in order to enable an area most likely to be used, rather than an area that corresponds to a political boundary, with predictable results.

**Regarding claim 10**, Barkowski further discloses that the enabling of useful data includes granting of a use authorization for an area defined by the user (DE: P19 and 23-25, or MT: page 4 paragraph 4 and page 5 paragraphs 1-3, etc) transmitted via a radio signal (DE doc: paragraph 17, or MT: page 4 paragraph 2, etc).

Barkowski does not disclose defining the area by the user by defining a center point and a radius of a circular region.

In the same field of endeavor, Person discloses a similar method for operating a vehicle navigation system including an area defined by the user by defining a center point and a radius of a circular region (fig 4, col 3: 44-51, col 7: 16- col 8: 12, etc).

It would have been obvious at the time of the applicant's invention to modify Barkowski to define the area by center point and radius, as taught by Person, in order to authorize an area most likely to be used, rather than an area that corresponds to a political boundary, with predictable results.

**Regarding claim 12**, Barkowski further discloses that the enabling takes place in a time-limited manner (DE: paragraph 22, or MT: page 3 paragraph 7, claim 13, etc). The area is enabled for only a certain period.

**Regarding claim 13**, Barkowski further discloses that the area defined by the user is not limited to any political boundary (DE: paragraph 23-24, MT: page 5 paragraphs 1-2, etc: multiple political regions can be enabled, therefore enabled area is not limited to any single political boundary).

See also Person (fig 4, col 3: 44-51, col 7: 16- col 8: 12, etc).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Chen whose telephone number is (571) 270-1330. The examiner can normally be reached Mondays through Fridays, between 10:00 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached at (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://www.uspto.gov/ebc>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Chen/

Patent Examiner

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July 18, 2011